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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88674888
Applicant	Garan Services Corp.
Applied for Mark	MATCH STUDIO
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Date	08/30/2021

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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Applicant: Garan Services Corp.

Serial No.: 88674888

Mark: **MATCH STUDIO**

Filing Date: October 31, 2019

Examiner: John R. Nehmer

Law Office: 121

**APPLICANT'S REPLY APPEAL BRIEF**

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Applicant submits this reply to the Examining Attorney's appeal brief, dated August 8, 2021 and respectfully requests that the Board reverses the refusal.

## I. ARGUMENT

A likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

As demonstrated herein, in Applicant's initial brief and by the record below, the Examining Attorney has turned a blind-eye to compelling facts and evidence that are probative to the analysis, and which tip the scale in favor of the registration of Applicant's mark. Furthermore, the Examining Attorney has misapplied the relevant case law to fit predetermined conclusions and assumptions concerning the meaning of the common element presented in the extant third-party registrations and commercial uses Applicant has made of record.

The Examining Attorney argues (1) that the STUDIO element in Applicant's mark is merely descriptive. Therefore, it does not have any effect on the MATCH portion and the commercial impression created by Applicant's mark as a whole; (2) the design element in one of the cited marks, , does not "significantly differentiate" the marks; and (3) none of the third-party registrations and commercial uses that show the common element MATCH being registered and used for apparel goods have any probative value for a variety of reasons, which Applicant will address further below.

A. The Third-Party Registrations and Uses  
Demonstrates that MATCH is Weak and Diluted

As Applicant has contended throughout these proceedings, the word “match” has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990). In an effort to rebut this fact, the Examining Attorney has cherry-picked some of the third-party registrations and uses made of record to criticize, while ignoring others. *Cf.* Applicant’s Main Brief, p. 6; Applicant’s Response to First Office, dated August 10, 2020, Exhibit B; Applicant’s request for Reconsideration, Exhibit A. The Examining Attorney has segregated the selected registrations into five categories. However, most of the Examiner Attorney’s arguments strain credulity. Applicant will address the first four categories pertaining to registrations only and concedes that the few published applications made of record are irrelevant.

The Examining Attorney contends that the first category of cherry-picked marks (see Opposition Brief, pp. 10-11) utilize “match” as a verb, which causes them to take “on a completely different meaning than the marks at issue.” The Examining Attorney fails however to explain what these differences are and how they factor into the analysis. Applicant submits that the marks clearly show the word “match” being used in the context of assembling things that are complementary or that fit together in some way. Whether it is used as a verb, noun or adjective, the connotation is the same. Each of the registrations cover apparel goods and the connotation of the term “match” in all of these cases is indisputable when viewed in connection with the goods. For example, marks such as MATCH WITH MOMMY; MIX, MATCH, IMAGINE!; MATCH MUCH; MATCH-RIGHT; MIX & MATCH; SNAPPIES MATCH EVERYTHING ... IN A SNAP indisputably evoke the same connotation, as it relates to the common element at issue, the word “match.”

The Examining Attorney contends that the second category of marks connote sports events as they are known sports phrases. See Opposition Brief, pp. 11-12. However, while these may be familiar sports-type phrases, the registrations all cover apparel goods. These uses are all clear attempts at presenting a double entendre. When viewed in the context of apparel goods, the use of the term “match” becomes obvious. The Examining Attorney’s creative and personal assumptions cannot overcome these facts and the relevant law, which states that “the meaning or connotation of a mark must be determined in relation to the named goods or services.” See, TMEP §1207.01(b)((v), citing, *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987).

In the third category, the Examining Attorney contends that the registrations do not contain the word “match.” See Opposition Brief, p. 12. Instead, they contain words that closely resemble the word “match,” such as MATCHES; MATCHLESS; MATCHUMAN. This argument clearly fails. “Matches” is the singular form of the word match; Matchless is the antithesis of match; MATCHUMAN is a creative way of saying “match you man.” Each of these examples supports Applicant’s contention concerning the common element in the marks at issue – i.e., “match” is highly suggestive.

The fourth category (Opposition Brief, p. 13) highlights marks in which the Examining Attorney believes that since there are “so many” additional elements in the marks, “match” is “rendered a minor element and does not stand out.” Nonetheless, these marks contain the word “match,” the registrations cover apparel goods and the connotation of this common element is consistently the same as with the other registrations the Examiner has address or has failed to do so.

With regard to the third-party uses, Applicant has submitted at least 24 uses of the word MATCH being used a trademark. The Examining Attorney has contended that none of these uses are relevant to the discussion. However, he has only challenged three of the examples submitted, while ignoring the remaining 21. The Examining Attorney's silence speaks volumes and Applicant reiterates its contention that the third-party used made of record further support that MATCH is highly suggestive and weak.

B. Applicant's Marks is Distinguishable

While the Examining Attorney's opposition brief is devoid of any assessment concerning the connotation and commercial impression created by the marks at issue, he continues to take the position that the STUDIO element in Applicant's mark is merely descriptive and therefore, does not have any effect on the MATCH portion and commercial impression created by Applicant's mark as a whole. This argument is plausible only if the Examining Attorney can show that the word MATCH should be granted a broad scope of protection when used in connection with apparel goods and that the third-party registrations and uses made of record are of no relevance.

As Applicant has noted in its opening brief, the Examining Attorney provides no authority for its proposition and contrary thereto, "the addition of matter to a mark may be sufficient to avoid a likelihood of confusion, **if the common portion of the marks is weak because it is merely descriptive or diluted.**" See Applicant's Brief, pp. 9-10 (emphasis in original). Given the plethora of MATCH-formative marks on the register in Class 25 and the numerous third-party uses made of record, Applicant's MATCH STUDIO is sufficiently different to avoid consumer confusion.

Furthermore, the additional design element, namely, ‘seven stylized matchsticks, one that runs in a straight vertical line through the center of the word “MATCH” and six others, three to either side of the central vertical stylized matchstick, that are increasingly curved in an outward facing direction the further each such stylized matchstick is from the central vertical stylized matchstick,’ in one of the cited marks is clearly significant in assessing the commercial impression created by that cited mark. The word “match” surrounded by numerous matchsticks does not have the same connotation or create the same commercial impression as MATCH STUDIO. Applicant’s mark, suggests a place where mix and matching of clothing takes happens as opposed to the act of matching or matchsticks.

## **II. CONCLUSION**

In light thereof, Applicant respectfully requests that the Board reverses the final refusal under §2(d) of the Lanham Act and allow Applicant’s application to proceed to publication.

DATED: New York, New York  
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Respectfully submitted,  
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